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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,889	03/31/2004	Ori Gerstel	100101-000300US	9087
37490 7590 05/09/2008 Trellis Intellectual Property Law Group, PC 1900 EMBARCADERO ROAD SUITE 109 PALO ALTO, CA 94303				
EXAMINER				
ENG, DAVID Y				
ART UNIT		PAPER NUMBER		
2155				
NOTIFICATION DATE		DELIVERY MODE		
05/09/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

10/815,889

**Applicant(s)**

GERSTEL ET AL.

**Examiner**

DAVID Y. ENG

**Art Unit**

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-15,21,22,24,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,21,22,24,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Claims 2, 16-20, 23 and 25 have been cancelled. The active claims are 1, 3-15, 21-22, 24 and 26-27.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 22 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claim recites that the computer-readable storage medium comprises instructions. A collective of instructions is a program and therefore is non-statutory subject matter.

A computer-readable storage medium including instruction when executed by a processor would cause the processor to perform the steps recited in the claim combination would be statutory provided that the claim combination recites steps and not one or more instructions.

#### ***Claim Rejections - 35 USC § 112/ 1<sup>st</sup> par.***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-15, 21-22, 24 and 26-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to disclose a network planning tool being used prior to a time of operation of the digital network to define a recommended route as claimed. The planning tool is essential to practice the claimed invention. Without the planning tool, one of ordinary skill in the art would not be able to make and use the invention without undue experiments.

#### **Response**

Applicants identified [16] for support. The MetroPlanner™ by Cisco described in [16] is for designing a base system that provides targeted performance requested by a customer such as a service provider. The Cisco MetroPlanner™ is not for defining a recommended route at the time of operation of a digital network.

#### ***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-15, 21-22, 24 and 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preambles of the independent claims call for allocating a resource. However, the claim combination recites allocating a recommended route. There is no allocation of resource recited.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 5-13, 21-22, 24 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) in view of Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16].

**Claims 1, 3, 5-13, 21-22, 24 and 26**

See at least the abstract of Blouin. Blouin teaches creating a route list listing a plurality of routes. A node in the network of Blouin is allowed to choose the best available route from the route list. Blouin does not explicitly disclose that the list is created prior to a time of operation of a digital network. However, Cisco teaches a MetroPlanner disclosed in [16] for creating a route list prior to a time of operation of a digital network as admitted by Applicants in a communication filed on 2/4/2008. From the teaching of Cisco, it would have been obvious to a person of ordinary skill in the art to use the MetroPlanner to create the route list prior to a time of operation of the network so that the node is able to use the list to choose the best available route.

***Claim Rejections - 35 USC § 103***

**Claims 4, 27**

Claims 4 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16] further in view of Moure (USP 7,219,159).

Interpretation of the Moure reference has already been set forth in the last Office action. The interpretation is incorporated herein by reference thereto.

***Claim Rejections - 35 USC § 103***

**Claims 14, 15,**

Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blouin et al. (USP 7,249,169) and Applicant's admitted prior art The MetroPlanner™ by Cisco described in [16] further in view of Garfinkel (USP 5,408,600).

Interpretation of the Garfinkel reference has already been set forth in the last Office action. The interpretation is incorporated herein by reference thereto.

Applicant's arguments with respect to claims 1, 3-15, 21-22, 24 and 26-27 have been considered but are moot in view of the new ground(s) of rejection.

**Final**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DAVID Y. ENG** whose telephone number is 571-272-3984. The examiner can normally be reached on M-F from 8AM to 3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **SALEH NAJJAR**, can be reached on 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID Y. ENG/

Primary Examiner, Art Unit 2155